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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,297	11/02/2001	Jeff G. Hall	FORS-06675	1030

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MEDLEN & CARROLL, LLP
101 HOWARD STREET
SUITE 350
SAN FRANCISCO, CA 94105

EXAMINER

LU, FRANK WEI MIN

ART UNIT	PAPER NUMBER
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1634

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/033,297	HALL ET AL.	
	Examiner	Art Unit	
	Frank W Lu	1634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2006 and 22 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35,47 and 62-84 is/are pending in the application.
- 4a) Of the above claim(s) 64,69,70 and 74-77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35,47,62,63,65-68,71-73 and 78-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

CONTINUED EXAMINATION UNDER 37 CFR 1.114 AFTER FINAL REJECTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission of RCE on September 18, 2006 and the amendment filed on September 18, 2006 and December 22, 2006 have been entered. The claims pending in this application are claims 35, 47, and 62-84 wherein claims 64, 69, 70, and 74-77 have been withdrawn due to species election. Rejection and/or objection not reiterated from the previous office action are hereby withdrawn in view of the amendment filed on December 22, 2006. Claims 35, 47, 62, 63, 65-68, 71-73, and 78-84 will be examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 35, 47, 62, 63, 65-68, 71-73, and 78-84 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 35 is rejected as vague and indefinite in view of step a) because it is unclear why step a) has a second cleavage structure without describing a first cleavage structure. Please clarify.

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5. Claim 62 is rejected as vague and indefinite in view of step a) of claim 62 and claim 77. Although claim 77 requires that said non-target cleavage product is generated from said first nucleic acid molecule while step a) of claim 62 does not require that said first nucleic acid molecule contains an unpaired region in the first cleavage structure and 5' portion of said second nucleic acid molecule is completely complementary to said first region of said first target nucleic acid, it is unclear how to generate said non-target cleavage product from said first nucleic acid molecule by cleaving said first cleavage structure with a cleavage agent comprising a 5' nuclease. Please clarify.

6. Claim 62 is rejected as vague and indefinite in view of step a) of claim 62 because it is unclear how said first cleavage structure can be formed in the presence of a cleavage agent comprising a 5' nuclease. Please clarify.

7. Claim 69 is rejected as vague and indefinite because it is unclear how said thermostable 5' nuclease can comprise a 5' nuclease of a DNA polymerase since nuclease and DNA polymerase are different enzymes which have different biological properties. Please clarify.

8. Claim 77 is rejected as vague and indefinite because the phrase "said non-target cleavage product from said first nucleic acid molecule is generated in concentration excess compared to said duplex" does not make sense. Does this phrase mean that said non-target cleavage product generated from said first nucleic acid molecule is in concentration excess compared to said duplex? Please clarify.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 35, 47, 62, 63, 65-68, 71-73, and 78-84 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 7,195,871 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because an obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but examined claims in this instant application are not patentably distinct from the reference claims because the examined claims are either anticipated by, or would have been obvious over, the reference claims. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). Although claims 35, 47, 62, 63, 65-68, 71-73, and 78-84 in this instant application are not identical to claims 1-18 of U.S. Patent No. 7,195,871 B2, claims 1-18 of U.S. Patent No. 7,195,871 B2 are directed to the same subject matter and fall entirely within the scope of claims

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35, 47, 62, 63, 65-68, 71-73, and 78-84 in this instant application because: (1) the content of U.S. Patent No. 7,195,871 B2 indicates that a cleaved probe accumulates exponentially over time as recited in step c) of claim 35 and steps c) and d) of claim 62 (see column 71, lines 16-43); (2) the content of U.S. Patent No. 7,195,871 B2 indicates that the first nucleic acid molecule is in concentration excess compared to said target nucleic acid (see column 12, first paragraph); (3) the content of U.S. Patent No. 7,195,871 B2 indicates that FEN nuclease is FEN-1 from *Pyrococcus woesei* (see column 18, second paragraph); and (4) the content of U.S. Patent No. 7,195,871 B2 indicates that a second cleavage structure is generated and cleaved (see columns 12 and 13). In other words, claims 35, 47, 62, 63, 65-68, 71-73, and 78-84 in this instant application are anticipated by claims 1-18 of U.S. Patent No. 7,195,871 B2.

Conclusion

11. No claim is allowed.

12. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM.Fax Center number is (571)273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571)272-0735.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

A handwritten signature in cursive script, appearing to read 'Frank Lu', is positioned above the printed name and title.

March 30, 2007

FRANK LU
PRIMARY EXAMINER